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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/707,313	12/04/2003	Fides Carlos	60655.2400	1312

20322 7590 11/24/2004

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EXAMINER


HAMILTON, LALITA M

ART UNIT	PAPER NUMBER
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3624

DATE MAILED: 11/24/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.		Applicant(s)	
	10/707,313		CARLOS ET AL. 	
	Examiner		Art Unit	
	Lalita M Hamilton		3624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 6-9 are rejected for the following reasons:

In claims 6 and 8, "nominated bank", "credit", and "required presentation" lack antecedent basis.

Claims 7 and 9 are rejected for their dependency upon rejected claims.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-5 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

35 USC 101 requires that in order to be patentable the invention must be a "new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof" (emphasis added).

Claims 1-5 are rejected under 35 U.S.C. 101, because the claimed invention is directed to a non-statutory subject matter. Specifically the method claims as presented do not claim a technological basis in the pre-amble and the body of the claim. Without a claimed basis, the claim may be interpreted in an alternative as involving no more than a manipulation of an abstract idea and therefore non-statutory under 35 U.S.C. 101. In

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contrast, a method claim that includes in the body of the claim structural / functional interrelationship which can only be computer implemented is considered to have a technological basis [See Ex parte Bowman, 61 USPQ2d 1669, 1671 (Bd. Pat. App. & Inter. 2001) - used only for content and reasoning since not precedential].

In order to over come the 101 rejection above, the following preamble is suggested:

-A computer implemented method for ----, or something similar. Also, in the body of the claim include structural / functional interrelationship which can only be computer implemented.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Narayan (US 2004/0088245) in view of Dunlop (US 2002/0103754).

Narayan discloses a method and corresponding system and computer program product for producing documentary credit comprising an issuing bank issuing a credit in favor of a beneficiary upon application by an applicant, an advising bank advising said credit to said beneficiary, and a nominated bank receiving at least one document presented under the credit for at least one of payment, acceptance, and negotiation (p.2, 26; p.3, 33 to p.4, 35; and p.7, 50); a module and computer readable program code logic for storing criteria by which compliance with program conditions may be determined, where said program conditions are agreed between said nominated bank and an issuing pursuant to which said bank, a module and computer readable program code logic for storing criteria by which conformity of said document to stipulated documents specified in said credit may be determined, a module and computer readable program code logic for receiving said document, a module and computer readable program code logic for determining the compliance of said credit and said document to said program conditions in accordance with stored criteria relating to said program conditions, a module and computer readable program code logic for examining said document for conformity to said stipulated documents in accordance with stored criteria relating to said required presentation, and where said document is determined to be with said required presentation, and said in conformity credit and said document in compliance with said program conditions, and a module and computer readable program code logic for at least one of paying, accepting, and negotiating said credit with no or limited recourse to said issuing bank for discrepancies in said document (p.2, 26; p.3, 33 to p.4, 35; and p.7, 50); and where said document is determined to be

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discrepant, a module and computer readable program code logic for requesting a

~~waiver of the discrepancy from said issuing bank as provided in said program~~

conditions, and where said waiver is obtained, a module and computer readable

program code logic for at least one of paying, accepting, and negotiating said credit with

no or limited recourse to said issuing bank for other discrepancies in said document, or

where not obtained, a module and computer readable program code logic for disposing

of said document as provided in said program conditions without at least one of

payment, acceptance, and negotiation. Narayan is silent with regard to the nominated

bank and said issuing bank have agreed to program conditions pursuant to which said

nominated bank, based upon its own examination of said document and before said

document is forwarded to, received, and accepted by the issuing bank, will at least one

of pay, accept, and negotiate said credit with no or limited recourse to said issuing bank

for discrepancies in said document, said nominated bank examining said document for

conformity to stipulated documents specified in said credit, and where said document is

determined to be in conformity with said stipulated documents, and where provided in

said program conditions, said nominated bank at least one of paying, accepting, and

negotiating said credit with no or limited recourse to said issuing bank for discrepancies

in said document; credit being restricted for negotiation to an office maintained by said

nominated bank; credit is not restricted for negotiation to an office maintained by said

nominated bank, and wherein said nominated bank is designated as a reimbursing

bank, further comprising at least one intermediary bank receiving said document, and

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said intermediary bank forwarding said document to said nominated bank for at least one of examination, payment, acceptance, and negotiation; nominating bank confirms said credit; said document is determined to be discrepant, further comprising requesting a waiver of the discrepancy from said issuing bank as provided in said program conditions, and where said waiver is obtained, said nominated bank at least one of paying, accepting, and negotiating said credit with no or limited recourse to said issuing bank for other discrepancies in said document, or where not obtained, said nominated bank disposing of said document as provided in said program conditions without at least one of payment, acceptance, and negotiation. Dunlop teaches an online documentary letter of credit trade transaction and settlement method and corresponding system and computer program product comprising a bank that may act as the issuing bank, advising bank, negotiation bank, and reimbursing bank (p.3, 104-112) having the capability of performing the function of agreeing to program conditions pursuant to which said nominated bank, based upon its own examination of said document and before said document is forwarded to, received, and accepted by the issuing bank, will at least one of pay, accept, and negotiate said credit with no or limited recourse to said issuing bank for discrepancies in said document, said nominated bank examining said document for conformity to stipulated documents specified in said credit, and where said document is determined to be in conformity with said stipulated documents, and where provided in said program conditions, said nominated bank at least one of paying, accepting, and negotiating said credit with no or limited recourse to said issuing bank for discrepancies in said document; credit being restricted for negotiation to an office maintained by said

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nominated bank (; credit is not restricted for negotiation to an office maintained by said nominated bank, and wherein said nominated bank is designated as a reimbursing bank, further comprising at least one intermediary bank receiving said document, and said intermediary bank forwarding said document to said nominated bank for at least one of examination, payment, acceptance, and negotiation; nominating bank confirms said credit; said document is determined to be discrepant, further comprising requesting a waiver of the discrepancy from said issuing bank as provided in said program conditions, and where said waiver is obtained, said nominated bank at least one of paying, accepting, and negotiating said credit with no or limited recourse to said issuing bank for other discrepancies in said document, or where not obtained, said nominated bank disposing of said document as provided in said program conditions without at least one of payment, acceptance, and negotiation. It would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate the functions of agreeing to program conditions pursuant to which said nominated bank, based upon its own examination of said document and before said document is forwarded to, received, and accepted by the issuing bank, will at least one of pay, accept, and negotiate said credit with no or limited recourse to said issuing bank for discrepancies in said document, said nominated bank examining said document for conformity to stipulated documents specified in said credit, and where said document is determined to be in conformity with said stipulated documents, and where provided in said program conditions, said nominated bank at least one of paying, accepting, and negotiating said credit with no or limited recourse to said issuing bank for discrepancies

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in said document; credit being restricted for negotiation to an office maintained by said nominated bank (~~credit is not restricted for negotiation to an office maintained by said~~ nominated bank, and wherein said nominated bank is designated as a reimbursing bank, further comprising at least one intermediary bank receiving said document, and said intermediary bank forwarding said document to said nominated bank for at least one of examination, payment, acceptance, and negotiation; nominating bank confirms said credit; said document is determined to be discrepant, further comprising requesting a waiver of the discrepancy from said issuing bank as provided in said program conditions, and where said waiver is obtained, said nominated bank at least one of paying, accepting, and negotiating said credit with no or limited recourse to said issuing bank for other discrepancies in said document, or where not obtained, said nominated bank disposing of said document as provided in said program conditions without at least one of payment, acceptance, and negotiation, as may be suggested by Dunlop into the invention disclosed by Narayan, to protect against loss.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lalita M Hamilton whose telephone number is (703) 306-5715. The examiner can normally be reached on Tuesday-Thursday (8:30-4:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on (703) 308-1065. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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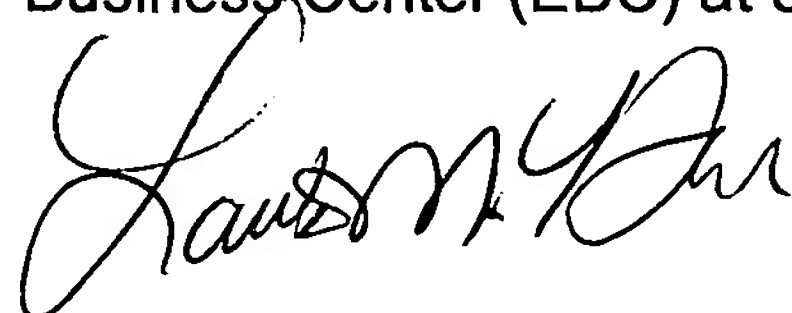
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LMH